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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,495	12/13/2000	Louis A. Schick	20-LC-2099/624226.289	3646

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EXAMINER

FISHER, MICHAEL J

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/736,495

Applicant(s)

SCHICK ET AL.

Examiner

Michael J. Fisher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 and 37-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31, 37-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6,10 and 20-30 are rejected under 35 U.S.C. 102(e) as being anticipated by US PAT 6,330,499 to Chou et al. (Chou).

As to claims 1,21,22,23,24,25, Chou discloses a computerized method for managing a plurality of mobile assets (title) comprising: collecting data from each of a plurality of assets via a transmitter (fig 1), providing a set of rules comprising relationships for the processing the data to determine the wear (fig 3), processing the data according to the rules to develop historical data (in data repository 203) and distributing the information via a global information network (abstract, lines 10-12) .

As to claim 20, Chou discloses using the data to develop a fault prediction (col 6, lines 6-8, "potential of a fault").

As to claim 26, Chou discloses a cost-benefit evaluation for a proposed future plan for use (col 4, lines 50-53 would inherently have such a cost-benefit evaluation as

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telling the user to "stop now" would denote that to keep driving would cost more as the repairs would be more extensive).

As to claim 30, Chou discloses knowing warranty information (col 5, line 36).

As to claims 2,27, the data is enhanced with environmental information collected during the actual usage (col 5, lines 53-60).

As to claim 3, Chou discloses determining a service recommendation (200, as best seen in fig 1).

As to claim 4, the service recommendation is communicated to the operator of the vehicle (abstract lines 10-12).

As to claim 5, Chou recommends the service center (175 or "dealer" as best seen in fig 1).

As to claim 6, the roadside assistance would be dispatched to where the vehicle is, thereby meeting the limitations as claimed.

As to claim 10, Chou discloses collecting data regarding service functions (col 4, lines 30-36).

As to claims 28, 29, Chou discloses basing decisions on previous services (col 5, lines 34-39).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7-9,11, 15-19 and 31, 37-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou.

Chou discloses a system and method as discussed above.

As to claim 7, it would have been obvious to one of ordinary skill in the art to base the suggested service on whether the service center is part of a chain to ensure the vehicle is serviced at an appropriate service center (such as suggesting that a Ford owner take the car to a Ford dealer and not a Chevrolet dealer).

As to claims 8,11, it would have been obvious to one of ordinary skill in the art to use a web page as Chou discloses using the Internet and this would allow the customer to check the information at the customer's time instead of at the help-desk's time.

As to claim 9, it would have been obvious to use cargo as a parameter as loading a vehicle with extra weight is well known to cause more wear.

As to claims 15,16,17, it would have been obvious to one of ordinary skill in the art to use the system and method as disclosed by Chou to ensure compliance with regulatory compliance as Chou teaches it as a good way to track vehicles and many commercial vehicles are required to comply with regulations.

As to claim 18, it would be obvious to notify the customer of promotions as Chou discloses notifying the customer of other services (col 10, lines 1-11, such as "concierge services").

As to claim 19, it would have been obvious to one of ordinary skill in the art to use the system and method as disclosed by Chou to ensure compliance with regulatory compliance as Chou teaches it as a good way to track vehicles and many commercial vehicles are required to comply with regulations.

As to claim 31, it is well known in the art to void a warranty based on compliance with service recommendations (for instance, if you have never changed, checked or added oil as per service recommendations and the engine is ruined, a warranty could be voided.).

As to claims 37-47, Chou discloses a system and method as discussed above. Chou does not, however, teach using it for locomotives. It would have been obvious to one of ordinary skill in the art to use the system and method as taught by Chou for locomotives as locomotives also require periodic maintenance and further, can break down.

Response to Arguments

Applicant's arguments filed 1/5/07 have been fully considered but they are not persuasive. The examiner will note that faults are "levels of wear", for instance, if brakes are bad, they are "worn out". The examiner will further note that it is not necessary that the inventions are "identical" for a rejection under 35 U.S.C. 102, merely that all

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limitations are included. As to arguments in relation to system claims such as those brought forth in relation to 22, the limitation "for (performing a function).." merely means that the device be capable of performing the function, not that it actually performs the function. As the examiner has shown that the prior art discloses that the function is actually performed, the examiner has more than met the requirement of the relevant statutes.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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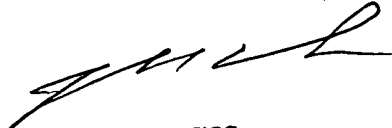
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Fisher whose telephone number is 571-272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

3/15/07


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